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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,490	01/09/2002	Yuki Nakamura	2271/66507	9287
Ivan S. Kavrukov Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036				
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EXAMINER				
ANGEBRANDT, MARTIN J				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/044,490

Applicant(s)

NAKAMURA ET AL.

Examiner

Martin J. Angebrannt

Art Unit

1795

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2008 and 03 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21, 24, 27, 30, 44-54, 58-61 and 63-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 24, 27, 30, 44-54, 58-61 and 63-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/19/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. The response of the applicant has been read and given careful consideration. Responses to the arguments of the applicant are presented after the first rejection to which they are directed.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osakabe '763, in view of Ando et al. '175 and Suzuki JP 11-134691.

Osakabe '763 teaches a test recording where the laser power is varied between 11 and 18 mW in 15 (0.5 mW) steps to record test information in the power calibration area. (5/40-60)

Ando et al. '175 describes the embossing of data relating to disk size, read out rate, recording density, serial numbers, linear velocity conditions, read power, peak power, base power and manufacture information (15/55-16/9)

Suzuki JP 11-134691 (machine translation attached) teach the determination of the performance characteristics of an optical recording medium including the optimum recording power based upon the sensitivity of the medium (gamma) [0003,0032,0052]. The use of both of these allows a range (margin) of useful laser powers and prevents selection of an improper laser power. [0059]

To support the assertion that embossing information relative to the performance characteristics of the optical recording media would have been obvious, the examiner cites Ando

et al. '175 which teaches the provision of control data and specification data for the optical recording medium in a non-write-able portion of the medium and Suzuki JP 11-134691 which describe specific methods of characterizing the performance and holds that it would have been obvious to one skilled in the art to modify the media of Osakabe '763 by determining the performance characteristics and recording this information as described by Suzuki JP 11-134691 to prevent improper choice of laser powers and to provide at least some of this data as embossed information as described by Ando et al. '175 to allow the user for forgo the optimization process.

The applicant's arguments neglects to recognize that the values of R and S actually correspond to real parameters in the recording process, but these values are not recorded in the medium as the values of P_i and P_o are, but are chosen when writing to the medium. These really limit the process of use, not the medium as they are never written into the medium. The examiner reiterates that the claims are to the media, not the process of use. Were the claims directed to the process of use, the applicant's arguments would be at least more persuasive as the reference determines the same basic information (the optimum operating parameters) for the medium. In particular the optimum recording power range and the sensitivity of the medium.

The only information recorded is that of the test runs, The claims do not recite that the values of S or R are stored on the medium. The applicant should insert language clearly stating this into the claims and address the issue raised by the teachings of Ando et al. '175. The recording of test runs is taught in Suzuki JP 11-134691. The current language describes selecting the values of S and R and calculating other, but does not describe where they are stored. Currently this includes both on the media and also on another drive on the computer.

The applicant's arguments neglect the fact that S are the desired values relating to the $g(P)$ which corresponds to the sensitivity of the medium described by Suzuki JP 11-134691, the optimum recording power is also determined in Suzuki JP 11-134691 and the R corresponds to the power margin discussed in Suzuki JP 11-134691. The applicant refers to P_t which is unrecited in the claim. The optimum recording value is P_o in the claims. Further, this value, the power margin and the sensitivity (γ) are described in Suzuki JP 11-134691. The calculation of $g(p)$ yields a sensitivity to power changes and the choosing a single value for S within the range defines the linear portion of the sensitivity curve ($D \log H$) and the minimum (base) recording power. The R value defines the range upward from that and defines the upper range of the useful power range with the medium. These parameters correspond to those discussed by Suzuki et al. '780, but go under different names. The rejection stands.

Claims 44-49 are directed to the optical recording medium, The claims describe the writing test recordings with recording powers P (the test recordings are written onto the medium). P_t , P_o , S and P_s are determined by reading out the test recordings and then performing calculations in the computer (not the medium) and the claims do not describe any of P_t , P_o , S and P_s being stored on the medium to materially change it. The claims therefore read on an optical recording medium having a test pattern recorded therein. The applicant's representative also fails to appreciate that the claims do not require storage of the laser powers. The claims limitations are almost exclusively describing processes, which are performed by the computer alone, without interaction with the recording medium. The examiner has interpreted the claims as requiring the information regarding the test recording recorded on the medium. The applicant states that R and S values are recorded

in the medium, but the claim language does not reflect this as the claims only recite the step of performing the test recording where data is necessarily written into medium.

The use of Suzuki JP 11-134691 addresses the argument raised by the applicant's statement of common ownership.

The language of the claims do not require the R and S values to be written as they are not described these as embraced by 'data written as test recording runs' The values of R is derived from the test recording value Ps as discussed in the prepub of the instant specification at [0064]. The prepub goes on the state that these numbers (S and R) **may** be recorded in advance in the recording medium [0065]. This clearly allows for the values to be not recorded/prerecorded in embodiments of the media bounded by the claims. The calculations recited use the numbers but never specify storage of them on the media. It does seem that the read power, peak power, base power recorded as embossed information of Ando et al. '175 is analogous to the performance data of Suzuki JP 11-134691. The applicant has not addressed the fact that S are the desired values relating to the g(P) which corresponds to the sensitivity of the medium described by Suzuki JP 11-134691, the optimum recording power is also determined in Suzuki JP 11-134691 and the R corresponds the power margin discussed in Suzuki JP 11-134691. The rejection stands.

4. Claims 21,24,27,30,49-54 ,58-61 and 63-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. EP 0717404, in view of Yamada et al. EP 0735158, Yamada et al. EP 1058249 and Mizuno et al. EP 1047056.

Yamada et al. EP 0717404 in examples 2 and 3 in table 2 have the compositions shown in tables 2 as the recording layer in media comprising a polycarbonate substrate, a 200 nm ZnS-

SiO₂ lower dielectric layer, a 25 nm AgInTeSb recording layer, a 30 nm ZnS-SiO₂ upper dielectric layer, a 100 nm Al alloy reflective layer and a 5 micron UV cured resin as the protective layer. The sum of the Te and Sb are 91 and 85.4 % respectively. Comparative examples 1 and 2 use the same structure and meet the limitations of the claims. (table 2, cont). The sum of the Te and Sb are 99.5 and 95.9 % respectively. The benefits of adding 2% nitrogen is illustrated in table 3 on page 12. The addition of Ti, Cr or Si to the reflective layer is disclosed. (8/29-31). The maximum number of overwrites is defined by the number before the 1 sigma jitter is above 35 ns. (13/50-51). The addition of Ge, C, N, O, Al, Ga, Se, Pd, or Pb to the recording layer is disclosed. (7/56-58). Level three describes discs with a C/N or 55 dB and erasability of -35dB. (10/16-17) The level denoted in the table corresponds to the conditions for determining the number of overwrites shown in the tables.

Yamada et al. EP 0735158 in examples 3, 5-7 comparative example 2 and 3 in table 2 have the compositions shown in tables 2 as the recording layer in media comprising a polycarbonates substrate, a 200 nm ZnS-SiO₂ lower dielectric layer, a 25 nm recording layer, a 30 nm ZnS-SiO₂ upper dielectric layer, a 100 nm Al alloy containing 1 % Si as the reflective layer and a 10 micron UV cured resin as the protective layer. The sum of the Te and Sb are 85.5, 92,92,91 and 94.5 % respectively. Example 10 in table 2 on page 13 also includes nitrogen. The addition of various elements to the recording layer is disclosed. (7/48-52). The use of various alloys of Al, Au, Ag and Cu are disclosed. (9/26-27). Level three describes discs with a C/N or 55 dB and eras ability of -35dB. (10/16-17) The level denoted in the table corresponds to the conditions for determining the number of overwrites shown in the tables.

Yamada et al. EP 1058249 in examples have a polycarbonate substrate, 50 nm ZnS-SiO₂ layer, a 15 nm Ag_{0.5}In₈Sb₆₄Tc₂₇Ge_{0.5} recording layer, a 25 nm ZnS-SiO₂ layer, a 120 nm Al alloy reflective layer and a protective layer, which is used at 8X and evidences 3T jitter of 31 ns after 100 overwrites (the sum of the Sb and Tc content is 91) [0085-0092]. The AgInTeSb compositions can be Ag₉₋₁₀In₂₋₁₂Sb₅₅₋₇₀Tc₂₂₋₃₂Ge₀₋₅ [0041-0047]. The addition of various materials including B,N,C,Si,Ge and Sn as impurities in amounts of up to 5% to improve the performance and the reliability of the recording layer is disclosed. [0046]. Also note examples 6-8 which use Ge, C and N as impurities. The reflective layer can be Al,Au,Ag,Cu, Ta and alloys thereof with additives such as Cr, Ti, Si, Cu, Ag, Pd, or Ta [0071].

Mizuno et al. EP 1047056 teach phase change optical recording media using compositions having SbTe and additives including at least one of Ge and the like [0053]. Reflective layer compositions include Al alloys with 0.2 to 2.0 % Ta, Ti, Co, Cr, Si, Sc, Hf, Pd, Pt, Mg, Zr, Mo or Mn to increase durability, deposition rate and volume resistivity [0183]. The use of Ag alloys including 0.2 to 5 % Ti, V, Ta, Nb, W, Co, Cr, Si, Ge, Sn, Sc, Hf, Pd, Rh, Au, Pt, Mg, Zr, Mo, or Mn in increase heat dissipation, increase productivity and stability [0187-0188].

It would have been obvious to one skilled in the art to modify the cited inventive examples of Yamada et al. EP 0717404 having the level 3 performance such as example 3 of Yamada et al. EP 0717404 in a manner similar to example 17 shown in table 3 (page 12) but using Ge rather than nitrogen based upon the disclosure to add Ge at (7/56-58) in place of nitrogen based upon this teachings of equivalence and that of Yamada et al. EP 1058249 evidencing that the addition of either of these elements resulting in improvements in the thermal stability of the marks formed and more reproducible mark dimensions with a reasonable

expectation of forming a useful optical recording medium with level 3 performance and jitter of less than 35 ns and to use thinner recording layers to improve the responsivity and allow higher speed recording such as that taught by Yamada et al. EP 1058249 noting the thicknesses for the recording layer of less than 30 nm by Yamada et al. EP 0717404 at 7/24-25, 10-100 nm in Yamada et al. EP 0735158 at 6/52-55 and 12-30 nm by Yamada et al. EP 1058249 at [0055] which are held to give a reasonable expectation of forming a useful optical recording medium with the desired performance and to use Al reflective layers containing 0.3-2.0% of Si, Cr, Ti or Ta or Ag layers containing 0.2 to 4% of Au, Pd, Pt, or Ti as disclosed by Mizuno et al. EP 1047056 in place of the single reflective layer composition disclosed with a reasonable expectation of forming a useful phase change optical recording medium based upon the disclosure of equivalence by Mizuno et al. EP 1047056 and the direction to the use of additives to the reflective layer by Yamada et al. EP 1058249 at [0071].

..

The applicant is claiming the medium in a product by process format, therefore contrary to the position of the applicant, a reasonable assertion by the examiner, based in part upon the properties of the media reported in the prior art for the media of the of the prior art, that the media of the prior art and the claimed media are the same places the burden firmly upon the applicant to show that the process of the prior art does not result in media within the scope of the coverage sought. There are no requirements in MPEP 2113 that the exact process used be the same. Phase change recording media are conventionally initialized in the art prior to use. The applicant's characterization of the reference's teachings (as well as those of the other references applied) through mere

restatement of the abstract is nowhere near a reasonable treatment of the complete teachings of the reference.

The examiner points to the high ratings of the various examples cited. These characteristics would not be present if the recording layer s was damaged. Further, applicant's own specification states "[0224] When the values shown in FIGS. 4 and 5 are compared, it is found that DOW 1 jitter tends to increase with decreasing energy density E. The range found for the E value is $E > 1000 \text{ J/m} \cdot \text{sup.2}$, for which jitter exceeds the 35 nsec that is specified as a standardized jitter value in the Orange Book " Bearing in mind the recording medium needs to conform with standards to be player reliably. The examiner holds that it is anticipated by the cited examples as it makes no sense to describe a medium as acceptable if it cannot be played on a conventional CD player. The examiner has pointed to the performance characteristics of the media, which meet or exceed the benefits ascribed to the resultant media. Therefore the examiner is correct in making the rejections asserted.

The media in the references are all initialized and as discussed previously, the applicant must show the criticality of this for the scope of coverage sought when using a product by process claim format (see MPEP 2113). The issue is not that the applicant has not properly drafted the claim, but that the showing that the resulting media which has improved performance noting the high number of overwrites taught for example 3 of Yamada et al. EP 0717404 (over 200,000). The claims are to the media, not the process of use and therefore the burden on the applicant is higher. The applicant argues that the media lack performance at higher velocities. The examiner notes that the assignee of Yamada et al. EP 0717404 and the instant application are the same and that the applicant may have data regarding the performance of the medium of

example 3 at higher velocities which could be presented as facts in a declaration to address the issues at hand. The rejection stands. The statement of rejection has been modified to parallel the statement of obviousness.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J. Angebranndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Martin J Angebranndt/
Primary Examiner, Art Unit 1795

Martin J Angebranndt
Primary Examiner
Art Unit 1795

10/22/2008